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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,148	12/31/2003	Masaki Okuyama	247103US0	6857
22850	7590	05/16/2008	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				VENKAT, JYOTHSNA A
ART UNIT		PAPER NUMBER		
1615				
NOTIFICATION DATE			DELIVERY MODE	
05/16/2008			ELECTRONIC	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/748,148	OKUYAMA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	JYOTHSNA A. VENKAT	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 19 March 2008.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 11-30 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 11-15 and 17-30 is/are rejected.  
 7) Claim(s) 16 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/19/08 has been entered.

Receipt is also acknowledged of declaration filed on 3/19/08. The amendment canceled claims 1-10 and added claims 11-30. Claims 11-30 are pending in the application and the status of the application is as follows:

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12, 18 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is new matter rejection.**

There is no support for the limitation of claim 12 at page 4. The support is for 0.5-10 denier.

There is no support for claim 18 limitation, wherein the polypropylene fibers are treated with silica and fluorine compound.

There is no support limitation of claim 21 at page 10.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23-24 and 29-30 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 23-24 are duplicates and claims 29-30 are duplicates.

***Claim Rejections - 35 USC § 103***

Claims 11-15,17, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of JP 2002-154932, machine translated text submitted by applicants (JP ‘932) and U. S. Patent 6,491,931 (‘931).

Instant application is claiming a cosmetic composition comprising:

1. Polypropylene fibers or polypropylene fibers treated with fluorine compound
2. Oil soluble resin

JP ‘932 teaches eyelash cosmetic using oil soluble resin and fibers treated with fluorine compound. See the abstract, see page 2 paragraph 9 for fibers. The fibers are nylon fibers, rayon fibers, cellulose fibers and polyester fibers. See paragraphs 12-22 for the fibers treated with various fluorine compounds. See paragraphs 6-7 for oil soluble resin. The difference between the JP ‘932 and instant application is JP ‘932 does not teach polypropylene fibers treated with fluorine compound. However patent ‘931 teaches cosmetic composition using fibers and film

forming polymer. Film forming polymers are also oil soluble resins. See the abstract; see col.2, ll 5-15 for the length of the fiber. Patent at col.2, ll 15-35 teaches various fibers and teaches equivalency between fibers of JP ‘931 and claimed polypropylene fibers. Patent ‘931 at col.2, ll 36-37 teaches that the fibers can be surface treated. See col.3, ll 5 through col.4, ll 27 for the film-forming polymer. See examples drawn to mascara.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composition of JP ‘932 using oil soluble resin and substitute fibers treated with fluorine compound of JP with polypropylene fibers and treat these fibers with fluorine compound in view of the equivalency between the fibers of JP and polypropylene fibers taught by patent ‘931 in mascara compositions. It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art. This is a prima facie case of obviousness.

Claims 22-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of JP 2002-154932, machine translated text submitted by applicants (JP ‘932) and U. S. Patent 6,491,931 (‘931) as applied to claims 11-15,17, and 19-21 above, and further in view of JP 2002-284642, machine translated text (JP ‘642).

Both the documents cited above do not teach the limitation, where in the oil soluble resin is obtained by fractionation of candelilla wax. However JP ‘642 teaches this limitation and using this resin in cosmetics. See paragraphs 1-9. See also paragraph 15.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composition of JP '932 using oil soluble resin and substitute fibers treated with fluorine compound of JP with polypropylene fibers and treat these fibers with fluorine compound in view of the equivalency between the fibers of JP and polypropylene fibers taught by patent '931 in mascara compositions and use oil soluble resin of JP 642. One of ordinary skill in the art would be motivated to modify the compositions of JP and use polypropylene fibers and use oil soluble resin of '642 with the reasonable expectation of success that the compositions has excellent eyelash curling effect and the presence of specific oil soluble resin 6 provide the advantage of providing a film that is excellent in adhesion to skin. This is a *prima facie* case of obviousness.

Applicants did not present arguments separately for rejection of claims (11-15,17, and 19-21) & (22-30), therefore the examiner will also respond similarly.

***Response to Arguments***

Applicant's arguments filed 3/19/08 have been fully considered but they are not persuasive.

Applicants' argue:

"New claim 11 recites a cosmetic composition for eyelashes comprising: polypropylene fibers having a thickness of from 0.1 denier to 12 denier, and a length of from 0.1 mm to 3 ram; and an oil soluble resin. In contrast, Kosugi describes a cosmetic composition for eyelashes comprising: synthetic fibers, such as nylon and rayon, having a thickness of 1-20 deniers, and a length of 0.5-5 mm; and an oil soluble resin (See e.g., abstract, [0010]).

Collin describes a cosmetic composition for keratin fibers comprising: synthetic fibers

selected from a plethora of various synthetic fibers, which include among the exhaustive list thereof, nylon, rayon, and polyolefin (e.g., polypropylene), having a length of 0.1-10 mm; and an optional wax (See e.g., abstract, column 2, lines 6-35, column 4, lines 28-67, column 5, lines 1-22, and Examples 1-3). Nylon and rayon are the only synthetic fibers exemplified in the Examples of Collin.

Tanaka describes a powdered cosmetic composition comprising a resinous fraction extracted from candelilla wax having a softening temperature of 35-55°C (See e.g., [0005]).

Neither Kosugi, nor Collin, when considered alone or in combination, provide sufficient motivation and guidance to direct a skilled artisan to particularly select the claimed polypropylene fibers from either the tremendously broad genus of synthetic fibers, or the particularly preferred nylon and rayon fibers, described therein. Even if sufficient motivation and guidance is considered to have been provided by Kosugi and Collin to direct a skilled artisan to particularly select the claimed polypropylene fibers, which is not the case, such a case of obviousness is rebutted by a showing of superior results, as evidenced by the comparative experimental data presented in Table 1 of the present specification, and Tables A-F of the § 1.132 Declaration appended herewith".

In response to the above argument, patent '931 at col.2, ll 15-35 teaches to one skilled in the art that any fibers can be used . Patent '931 teaches various fibers as functional equivalents. Therefore one of ordinary skill in the art would substitute fibers of JP with patent '931 expecting that the compositions are useful in mascara compositions.

***Response to Amendment***

The declaration filed under 37 CFR 1.132 filed 3/19/08 is insufficient to overcome the rejection of claims 11-15, 17 and 19-30 based upon JP '932, patent '931 and JP '642 as set forth in the last Office action because:

No.	Component	Example					Comparative Example				(\$)
		1	2	3	4	5	1	2	3	4	
(1) Stearic acid	3	3	3	3	3	3	3	3	3	3	
(2) Carnauba wax	5	5	5	1	5	5	6	6	5	5	
(3) Candelilla resin*1	5	5	5	10	1	5	-	5	5	5	
(4) Cetyl alcohol	1	1	1	1	1	1	1	1	1	1	
(5) Purified water	balance	balance	balance	balance	balance	balance	balance	balance	balance	balance	
(6) Triethanolamine	1.5	1.5	1.5	1.5	1.5	1.5	1.5	1.5	1.5	1.5	
(7) Polypropylene fiber*2	2	0.5	5	2	2	-	2	-	-	2	
(8) Polypropylene fiber*3	-	-	-	-	-	-	-	-	-	-	
(9) Nylon fiber*4	-	-	-	-	-	2	-	-	-	-	
(10) Rayon fiber*5	-	-	-	-	-	-	-	-	2	-	
(11) Alkyl acrylate copolymer emulsion*6	40	40	40	40	40	40	40	40	40	40	
(12) Methyl p-hydroxybenzoate	0.5	0.5	0.5	0.5	0.5	0.5	0.5	0.5	0.5	0.5	
(13) Chamomile extract	0.1	0.1	0.1	0.1	0.1	0.1	0.1	0.1	0.1	0.1	
(14) Black iron oxide	8	8	8	8	8	8	8	8	8	8	
(15) Silica*7	5	5	5	5	5	5	5	5	5	5	
<i>Items of evaluation and Results of determination</i>											
a Make-up effect (long ash effect)	00	0	00	00	00	Δ	0	Δ	0	0	
b Long-lasting of make-up effect	00	00	00	00	0	0	x	0	0	0	
c Usability of making-up	00	00	0	0	00	0	Δ	0	0	x	
d Uniformity of finished film	00	00	0	00	00	Δ	Δ	Δ	Δ	Δ	

\*1: softening point 47 to 48°C

\*2: 6 D, 1 mm, treated with 0.5% silica

\*3: 20 D, 4 mm, treated with 0.5% silica

\*4: 6 D, 1 mm, untreated

\*5: 6 D, 1 mm, untreated

\*6: solid content 40%

\*7: SYLVIA 550 (manufactured by Fuji Silysia Chemical Ltd.)

1. Declaration at page 2 has table 1. Table 1 is limited to polypropylene fibers treated with silica (0.5%). This corresponds to claim 16 and this claim was not rejected.

**Polypopylene untreated:**

2. Table A showed results with respect to polypropylene fibers untreated (weight percent 2, 0.5 and 5 and length 1 mm and thickness 6D) and oil soluble resin, which is candelilla resin and this resin has softening point 47-48 degrees Celsius and the weight percent is 5%.3.

Table B at page 4 showed results with respect to polypropylene fibers untreated (weight percent 2, 0.5 and 5 and length 2 mm, 3 mm and 0.5 mm and thickness 3D, 6D and 10D) and oil soluble resin, which is candelillia resin and this resin has softening point 47-48 degrees Celsius.

Table B at page 8 showed results with respect to polypropylene fibers untreated (weight percent 0.1 and 10 and length 0.5 mm and 3 mm and thickness 0.3D, 0.5D and 12D) and oil soluble resin, which is candelillia resin and this resin has softening point 47-48 degrees Celsius.

Table F at page 9 showed results with respect to polypropylene fibers untreated (weight percent 2% and length 2 mm and thickness 6D) and oil soluble resin, which are pentaerythrityl rosinate, trimethylsiloxy silicate, decamethylcyclopentasiloxane, polyisobutylene and polyvinylisobutyl ether and the weight percent of the resin is 5%.

None of claims 11-15, and 19-30 are limited to the showing in the declaration.  
Note that independent claim 1 recites no weight percent for the polypropylene fiber and weight percent and specific oil soluble resin

#### **Polypropylene treated with species belonging to formula (2)**

3. Table C at page 6 showed results with respect to polypropylene fibers treated with perfluoro alkyl silane (weight percent 2, 0.5 and 5 of the polypropylene fiber and length 2 mm, and thickness 6D and 5 % and 10% of the fluorine compound) and oil soluble resin, which is candelillia resin and this resin has softening point 47-48 degrees Celsius and the weight percent is 5.

4. Table D at page 7 showed results with respect to polypropylene fibers treated with perfluoro alkyl silane (weight percent 2, 0.5 and 5 of the polypropylene fiber and length 2 mm, and thickness 6D and 5 % of the fluorine compound) and oil soluble resin, which is candelillia resin and this resin has softening point 40-41 degrees Celsius and the weight percent is 1, 5 and 10.

There is no showing in the declaration to all the fluorine compounds disclosed and also taught by JP '656. The showing is very specific to one species in formula 2. All the fluorine compounds are drawn to divergent polymers and the same is true for formula 2.

(See In re Peterson, 315 F.3d 1325, 1329-31, 65 USPQ2d 1379, 1382-85 (Fed. Cir. 2003) (data showing improved alloy strength with the addition of 2% rhenium did not evidence unexpected results for the entire claimed range of about 1-3% rhenium); In re Grasselli, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983) (Claims were directed to certain catalysts containing an alkali metal. Evidence presented to rebut an obviousness rejection compared catalysts containing sodium with the prior art. The court held this evidence insufficient to rebut the *prima facie* case because experiments limited to sodium were not commensurate in *scope with the claims*).

In conclusion, the showing is not commensurate with the scope of claims

***Allowable Subject Matter***

Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 1615

Application is in condition for allowance subjecting to :

1. incorporating claims 15 and 21 and 22 into claim 1

2. incorporating claims 15 and 21 and 24 into claim 1 and reciting the specific weight

percent of fluorine compound and specific formula tested in the declaration and cancelling the claims that are redundant.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /  
Primary Examiner, Art Unit 1615

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